



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,287	02/26/2004	Masataka Kato	KATO28	1973

1444 7590 02/01/2006

BROWDY AND NEIMARK, P.L.L.C.  
624 NINTH STREET, NW  
SUITE 300  
WASHINGTON, DC 20001-5303

EXAMINER

HANNON, THOMAS R

ART UNIT PAPER NUMBER

3682

DATE MAILED: 02/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/786,287

**Applicant(s)**

KATO ET AL.

**Examiner**

Thomas R. Hannon

**Art Unit**

3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-12, 14 and 16-18 is/are rejected.
- 7) ☒ Claim(s) 9 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/9/06</u> | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 3682

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8, 14, and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nightingale in view of Glodin.

Nightingale discloses a rolling-contact bearing comprising an inside rotating member (10) having a guideway area made thereon with a first raceway (16), an outside rotating member (26) rotary relative to the inside rotating member and having a second raceway (28), and a cage (64) with rollers (18) spaced at a preselected interval around the cage to roll through a race defined between the first raceway on the inside rotating member and the second raceway on the outside rotating member. Glodin et al. discloses an antifriction bearing wherein the cage with the rolling elements is formed together with solid lubricant to lubricate the rolling elements running through the race into a complete unitary molding with the rolling elements being kept exposed partially at their circular rolling-surfaces out of the inside circular surface of the complete unitary molding. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the bearing assembly of Nightingale such that the cage member is molded with a solid lubricant, because this is taught and suggested by Glodin as increasing the service durability of a conventional bearing and to prolong its life.

With respect to claims 2-6, and 8, all the claimed features of the rolling contact bearing are found in Nightingale.

Art Unit: 3682

With respect to the claim language directed toward “a separate unitary molding” which can be “engaged or disengaged out of the race”, it is noted that its structure and not its process of making limitations define a product claim. The final product structure required of claim 1 is found and/or suggested by the combination of Nightingale in view of Glodin.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nightingale in view of Glodin et al. as applied to claim 3 above, and further in view of Herber et al.

Herber discloses a roller bearing in which the outer surface of the outer rotary member has a spherical configuration. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the outer surface of the outer member of Nightingale such that it includes a spherical configuration, because this is taught and suggested by Herber as providing the desired benefit of avoiding additional edge stressed from alignment errors.

Claims 9 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's arguments filed January 17, 2006 have been fully considered but they are not persuasive. Applicant notes in Nightingale “NO cage or solid lubricant is involved”. However, Nightingale does indeed involve a cage. Applicant notes in Glodin “the roller 5, antifriction material 1 and retainer 4 are not formed as separate unitary molding which can be engaged or disengaged from the assembled races”. However, Glodin is not relied upon for such a showing, but, as in the rejection as a teaching for providing the cage and roller assembly of Nightingale with a molded antifriction-cage-roller structure. The ability of the cage structure so combined to be able to be engaged and disengaged inherently results from such a combination, due to the

Art Unit: 3682

cylindrical structure of Nightingale. Applicant has noted differences between each of the individual reference with respect to the claim language, but has not shown the combination rejection to be improper. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas R. Hannon whose telephone number is (571) 272-7104. The examiner can normally be reached on Monday-Thursday (8:30-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on (571) 272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3682

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas R. Hannon  
Primary Examiner  
Art Unit 3682

trh